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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Barry H. Schwab

Application No.: 09/886,685 Confirmation No.: 8645

Filed: June 21, 2001 Art Unit: 2621

For: INTEGRATED MULTI-FORMAT AUDIO/VIDEO PRODUCTION SYSTEM Examiner: T. T. Vo

APPELLANTS' REPLY BRIEF

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In its Answer, the Examiner raises the new argument that "Shaw would obviously teaches [sic] the fractional of 24 fps and further suggests that various changes may be made for the decoding system." (Examiner's Answer, page 5). Appellants respectfully disagree. According to the Shaw reference, the host processor may be presented with *only five options*, namely, 30 frames per second, 15 frames per second, 7.5 frames per second, or 1 frame per second. The Examiner's analysis,, i.e., that 15 frames per second is equal to 24 divided by 1.6, 10 frames per second is equal to 24 divided by 2.4, and so forth, is misguided and is not derived from the prior art. Just because one number is divisible by a fraction does not render the result disclosed by a prior art reference. Accordingly, the Examiner's equations are irrelevant and do not support a finding of *prima facie* obviousness.

The Examiner's "basic principal of a proper prior art analysis within 35 U.S.C. §103(a)," have only to do with the sufficiency of a disclosure *if a combination is warranted in the first place*. The fact remains that in rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

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Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011,1017,154 USPQ 173, 177 (CCPA 1967), cert. denied, 389U.S. 1057 (1968). The Federal Circuit has *repeatedly* cautioned against employing hindsight by using the Appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir, 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

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Respectfully submitted,

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